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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,622	06/05/2006	David Thomas Forrest	52993/326894	5397

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ATLANTA, GA 30309

EXAMINER
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FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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11/12/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/581,622	<b>Applicant(s)</b> FORREST ET AL.	
	<b>Examiner</b> Lawrence D. Ferguson	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,7,8,31 and 32 is/are rejected.
- 7) ☒ Claim(s) 3-6,9-14 and 33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/17/09</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment mailed June 30, 2009.

Claims 31-33 were added rendering claims 1-14 and 31-33 pending.

### ***Claim Rejections – 35 USC § 102(b)***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 7-8 and 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Fei et al. (U.S. 5,831,367).

Fei discloses a structure being a planar article, which has a planar lamination of grain oriented materials (abstract and column 2, lines 30-37 and 55-59). Figure 3 shows the planar article has a planar direction and a normal direction, where the structure has a dimension in the planar direction that is larger than the dimension in the normal direction, as in claim 1. In claim 1, the phrase, “formed by chemical vapor deposition” introduces a process limitation to the product claim. For purposes of examination, product-by-process claims are not limited to the manipulation of the recited steps, only

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the structure implied by the steps. See MPEP 2113. In the present case, the recited steps imply a structure having a planar direction and a normal direction, wherein the structure has a dimension in the planar direction that is larger than the dimension in the normal dimension. The reference suggests such a product because Figure 3 shows the planar article has a planar direction and a normal direction, where the structure has a dimension in the planar direction that is larger than the dimension in the normal direction.”

Concerning claim 2, Figure 3 shows the structure is a flat ring having a circumference. Because the structure is a planar article having grains oriented in the planar direction, it is inherent for the grains to be oriented in a radial direction around the circumference of the ring. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of a newly-discovered property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art. Additionally, anticipation by a prior art reference does not require that the reference recognize the inherent properties that may be possessed by the prior art reference. See *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633 (Fed. Cir.) (1987).

Concerning claims 7-8, Figure 3 shows the structure is a flat ring that has a curved outer surface.

Concerning claim 31, Fei discloses a structure being a planar article, which has a planar lamination of grain oriented materials (abstract and column 2, lines 30-37 and

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55-59). Figure 3 shows the planar article has a planar direction and a normal direction, where the structure has a dimension in the planar direction that is larger than the dimension in the normal direction, as in claim 1. In claim 1, the phrases, "formed by chemical vapor deposition" and "structure is cut from a CVD formed tube of material" introduces a process limitation to the product claim. For purposes of examination, product-by-process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. See MPEP 2113. In the present case, the recited steps imply a structure having a planar direction and a normal direction, wherein the structure has a dimension in the planar direction that is larger than the dimension in the normal dimension. The reference suggests such a product because Figure 3 shows the planar article has a planar direction and a normal direction, where the structure has a dimension in the planar direction that is larger than the dimension in the normal direction."

Concerning claim 32, Figure 3 shows the structure is a flat ring having a circumference. Because the structure is a planar article having grains oriented in the planar direction, it is inherent for the grains to be oriented in a radial direction around the circumference of the ring.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fei et al (6,066,904) teaches a structure being a planar article, which has a planar lamination of grain oriented materials (abstract and Figure 3).

5. Claims 3-6, 9-14 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The closest prior art does not teach or suggest the recited structure further including silicon carbide. The closest prior art does not teach or suggest the recited structure further including CVD deposited silicon carbide comprising an opacifying dopant dispersed in the silicon carbide in an amount sufficient to provide an opacity greater than 10,000 times that of CVD-deposited silicon carbide.

The prior art does not teach motivation or suggestion for modification to make the invention as instantly claimed.

### ***Response to Arguments***

6. The rejection made under 35 U.S.C. 102(b) as being anticipated by Goela et al. (U.S. 6,464,912) is withdrawn due to the declaration submitted by David Slutz, Ph.D., which supported Applicant's argument that the grains of Goela are not oriented in a planar direction because Goela does not form its article from a tube or cylindrical material, as in the instant invention.

The rejection made under 35 U.S.C. 103(a) as being unpatentable over Goela et al. (U.S. 6,464,912) is withdrawn due to the declaration submitted by David Slutz, Ph.D., which supported Applicant's argument that the grains of Goela are not oriented in a

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planar direction because Goela does not form its article from a tube or cylindrical material, as in the instant invention.

Applicant's arguments of the rejection made under 35 U.S.C. 103(a) as being unpatentable over Goela et al. (U.S. 6,464,912) in view of Takeda et al (U.S. 6,515,297) are moot based on grounds of new rejection.

Applicant's arguments of the rejection made under 35 U.S.C. 103(a) as being unpatentable over Goela et al. (U.S. 6,464,912) in view of Ioku et al (U.S. 4,582,561) are moot based on grounds of new rejection.

Applicant's arguments of the rejection made under 35 U.S.C. 102(e) as being anticipated by Goela et al. (U.S. 6,939,821) are moot based on grounds of new rejection.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample, can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Lawrence Ferguson/  
Patent Examiner, Art Unit 1794

/David R. Sample/  
Supervisory Patent Examiner, Art Unit 1794